

REMARKS

In the Office Action,¹ the Examiner:

- (1) objected to the specification;
- (2) rejected claims 25 and 27-36 under 35 U.S.C. § 101;
- (3) rejected claims 1, 3-5, 7-13, 19-20, 25, 27-31, and 33-36 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,721,906 (*Siefert*) in view of U.S. Patent No. 6,820,082 (*Cook*) and U.S. Patent Application Publication No. 2003/0130994 (*Singh*);
- (4) rejected claims 6, 14-16, 18, and 32 under 35 U.S.C. § 103(a) over *Siefert* in view of *Cook*, *Singh*, and U.S. Patent Application Publication No. 2005/0086204 (*Coiera*); and
- (5) rejected claim 17 under 35 U.S.C. § 103(a) over *Siefert* in view of *Cook*, *Singh*, *Coiera*, and U.S. Patent No. 6,636,837 (*Nardozzi*).

Claims 1, 3-25, and 27-38 are pending in this Application, although claims 21-24 are withdrawn. By this Amendment, claims 1 and 25 are amended, and dependent claims 37-38 are added.

1. Objection to the Specification

The Office Action objects to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action asserts that while the specification discusses a machine readable medium, it allegedly does not disclose a machine readable storage medium. See Office Action, pg. 3.

The M.P.E.P. states, in relevant part, “[u]sually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs some terms that do not appear in the specification.” See M.P.E.P. § 608.01(o). “It should be noted, however, that exact terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112” (emphasis added). See M.P.E.P. § 1302.01.

As discussed above, there is no requirement that the language used in the claims be identical to the language in the specification. Indeed, in this case, it is clear that there is a substantial correspondence between the language of the claims and the language of the specification in the instant application. For example, the specification notes that exemplary embodiments of the invention include “a machine-readable medium storing machine-readable instructions.” As another example, exemplary embodiments of the invention include “a computer system” that can include “memory” that is used to “store and retrieve information.” See paragraphs [0025]-[0027]. Additionally, some exemplary embodiments could include “a storage resource such as a hard disk drive for storing and retrieving data for the computer.”

Since the language “machine-readable storage medium” is clearly supported by the specification, Applicant respectfully requests withdrawal of the objection to the specification.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

2. Rejections Under 35 U.S.C. § 101

The Office Action rejects claims 25 and 27-36 under 35 U.S.C. § 101 for allegedly not being directed to statutory subject matter because the phrase “machine-readable storage medium” is allegedly not defined in the specification. See Office Action, pgs. 3-4. Applicant respectfully traverses this rejection.

As discussed above, the phrase “machine-readable storage medium” is clearly supported by the specification of the instant application. The Office Action also asserts that the claims are not placed squarely within one statutory class of invention, asserting that in paragraph [0063], lines 7-10, “applicant has provided evidence that applicant intends the ‘medium’ to include signals. As such, the claim is drawn to a form of energy.” See Office Action, pg. 5. Applicant respectfully disagrees with this assertion.

Paragraph [0063] of the instant application clearly separates the term “machine-readable medium” from the term “machine-readable signal.” Specifically, the specification notes that that “the term ‘machine-readable medium’ refers to any computer product, apparatus and/or device (e.g., magnetic discs, optical discs, memory, Programmable Logic Devices (PLDs)” while “the term ‘machine-readable signal’” refers to a signal. Thus, contrary to the Office Action’s allegation, it is clear that the machine-readable storage medium of the claims is not a form of energy.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claims 25 and 27-36 under 35 U.S.C. § 101.

3. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of claims 1, 3-25, and 27-36 under 35 U.S.C. § 103(a) over a combination of *Siefert, Cook, Singh, Coiera, and Nardozzi*.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.”

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites, in part, “selecting a layout of the user interface from a plurality of layouts based on the first attributes.” Claim 25, although of different scope, recites a similar element.

Siefert discloses a system for managing resources, such as a book. *Siefert's* system includes a typical display which the GUI generates *after the computer's power-up sequence has been executed*. See col. 8, lines 46-48 of *Siefert*. Thus, *Siefert* discloses a pre-determined layout of a user interface, and not "selecting a layout of the user interface from a plurality of layouts based on the first attributes" as recited in claim 1.

Singh, Cook, Coiera and *Nardoizzi* fail to remedy the deficiencies of *Siefert*, as *Singh, Cook, Coiera* and *Nardoizzi*, alone or in combination, fail to teach or suggest at least "selecting a layout of the user interface from a plurality of layouts based on the first attributes," as recited in claim 1, and similar recitations in claim 25.

For at least these reasons, withdrawal of the rejections of claims 1 and 25, as well as the claims depending therefrom, is respectfully requested.

4. New Claims 37 and 38

New Claims 37 and 38 are allowable over the references at least based on their dependence on allowable claim 1.

5. Conclusion

In view of the foregoing, Applicants request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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